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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/27/2002

*Ep*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) 20-22, 24, 30-39, 41, 58 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-19, 23, 25-29, 40, 42-57, 59, 60 and 62-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Receipt is acknowledged of the response filed June 5, 2002. Claims 1, 16, 40, 45 and 63 have been amended. Claims 1, 3-60 and 62-67 are pending. Claims 20-22, 24, 30-39, 41, 58 and 67 have withdrawn. The status of claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60 and 62-66 is as follows.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is unclear what process Applicant actually intends to claim. It appears that amended claim 1 is now directed to an intended use of introducing an emulsion containing an alpha,omega-substituted oxyalkylenated silicone into a composition in order to reduce or eliminate the transfer or migration of the composition when the composition is put to use. In other words, the emulsion is only introduced into the composition if the composition is put to use. Alternatively, the introduction of the emulsion into the composition could be interpreted as the said putting the composition to use, which is a future intended use.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 331 833 A1 (833).

This rejection is maintained for reasons of record in the Office Action mailed February 26, 2002, paper no. 21.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 373 661 A2 (661) in combination with EP 0 796 615 A1 (615).

This rejection is maintained for reasons of record in paper no. 21.

***Response to Arguments***

Applicant's arguments filed June 5, 2002 have been fully considered but they are not persuasive.

Applicant argues that the Examiner has not shown anticipation of the process of claims 1 and 3-11 in EP '833. MPEP 2112.02 recites, "if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device." The instantly claimed process requires the step of introducing an emulsion containing an alpha,omega substituted oxyalkylenated silicone into a cosmetic, hygiene or pharmaceutical composition. Claim 10 of EP '833 clearly recites that the emulsified compositions containing the oxyalkylenated silicones of claim 3 are used as ointment and cosmetic bases. Composition bases are normally either added to another composition or have another composition added to them. Therefore, the normal and usual operation of the emulsified ointment and cosmetic bases of EP '833 would result in introducing the emulsified bases into cosmetic, hygiene and/or pharmaceutical compositions as instantly claimed.

Additionally, MPEP 2112.02 recites, "when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated." The instant process claims are directed to using the emulsions to obtain certain properties of compositions when they are used. The actual process step is merely introducing the emulsion into a

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composition, which is taught by the prior art as explained above. Therefore, although Applicant may have discovered a new use for an old composition, it does not render the claims patentable over the prior art. Discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 1655 and MPEP 2112.01.

Applicant argues that the combination of EP '661 and EP '615 does not teach or suggest reduced or eliminated transfer or migration, or non-therapeutic treatment of the skin and/or keratin fibers by using an effective amount of alpha,omega substituted oxyalkylenated silicones. The combination of EP '661 and EP '615 would result in a composition containing all of the components instantly claimed. One of ordinary skill in the art would expect a composition containing the same components to exhibit the same properties, absent evidence to the contrary. Applicant has not provided any evidence of record to show that the compositions of the prior art do not exhibit these properties. As to Applicants argument that the Examiner must show that the processes of using are obvious, not the emulsions employed therein, Applicant is referred to the discussion of MPEP 2112.02 above, which states that a process of using may be anticipated by the device used.

Applicant argues that Formulas (I) and (II) of EP '615 cited by the Examiner are not alpha,omega substituted silicones as instantly claimed. Applicant's attention is directed to Formula (I) when  $R_2$  is  $-C_6H_{2c}-O-(C_2H_4O)_a-(C_3H_6O)_b-R_5$ . This results in an alpha,omega substituted oxyalkylenated silicone as instantly claimed, which does not exclude pendant oxyalkylene substituents. Additionally,  $m$  may equal 0, in which case

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Formula (I) would not contain any pendant oxyalkylene substituents. The oxyalkylenated silicones of Formula (I) are disclosed as preferred in EP '615 at page 5, line 51. As to Applicant's arguments that only Formula (III) of EP '615 corresponds to the instantly claimed silicones and Formula (III) is not exemplified or preferred by EP '615, a reference is not limited to its preferred or exemplified embodiments. It would have been obvious to one of ordinary skill in the art to substitute any one of the silicones of EP '615 for another expecting the same results.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The motivation for combining the references is to obtain stable cosmetic compositions as disclosed in both EP '661 and EP '615. The motivation to select an alpha,omega substituted oxyalkylenated silicone comes from the teachings of EP '615 that the use of an alpha,omega substituted oxyalkylenated silicone would achieve similar results as a pendant substituted oxyalkylenated silicone.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

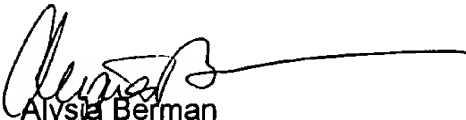
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Russell Travers, can be reached on 703-308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
August 26, 2002

  
RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200